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10/773,738	02/06/2004	Martin A. Gruber	GRUBER-0001	8610
25235 7590 05/28/2008 HOGAN & HARTSON LLP ONE TABOR CENTER, SUITE 1500 1200 SEVENTEENTH ST DENVER, CO 80202				
EXAMINER				
PHONGSVIRAJATI, POONSIN				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/773,738

**Applicant(s)**

GRUBER, MARTIN A.

**Examiner**

SIND PHONGSVIRAJATI

**Art Unit**

4176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-893)  
Paper No(s)/Mail Date 20040715
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

### ***Claim Objections***

2. Claim 9 is objected to because of the following informalities: an extra character "d" was found at the end of the claim. Appropriate correction is required.

3. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

4. The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph), or, in other words, that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

5. When, as here, an independent claim recites a particular method, a dependent claim drawn to an apparatus capable of performing the method of the independent claim is not a proper dependent claim if the apparatus might be used in other ways, since the dependent claim (the apparatus) could conceivably be infringed without infringing the basic claim (the method), in violation of the infringement test for proper dependency of claims. See MPEP § 608.01(n)(III).

6. Applicant is required to cancel the claim(s), amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-10 and 12-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Hacker (US 6,988,075), which also refers to Huerga (US 5,960,085) for prior art, and reference therein.

9. As to **Claim 1**, Hacker teaches a method of handling patient medical information (Hacker, Abstract), the method comprising:

- a. for a patient, creating a patient-centric electronic medical record by storing a plurality of data items about the patient in a patient-centric data structure (col.6 lines 14-17);
- b. establishing access permissions for the medical record, wherein the access permissions are patient-controlled (Hacker, col. 8 lines 4-17); and

- c. wherein the electronic medical record is owned by the patient and includes data items associated with an arbitrary number and variety of health care providers that have been used by the patent over the patient's lifetime (Hacker, col. 6 lines 14-24).
10. As to **Claim 2**, Hacker teaches the method of claim 1 in which the patient-centric electronic medical record further comprises: enabling the patient to control access to the patient-centric electronic medical record (Hacker, Abstract). At where visit if the length err the FFOF
11. As to **Claim 3**, Hacker teaches the method of claim 1 further comprising transporting the patient-centric electronic medical record over the Internet in accordance with the patient-controlled access permissions (Hacker, col. 7 lines 21-50).
12. As to **Claim 4**, Hacker teaches the method of claim 2 further comprising: specifying within the patient-centric electronic medical record specific access privileges for independently for each entity, including health care providers, physicians, hospitals, insurance companies, health maintenance organizations, and government agencies that may access the patient-centered record (Hacker, col. 5 lines 59-67).
13. As to **Claim 5**, Hacker teaches the method of claim 3 in which the act of establishing access permissions comprises establishing a right to read the patient-centric electronic medical record, write to the patient-centric electronic medical record and copy parts of the patient-centric electronic medical record (Hacker, col. 8 lines 4-

17); and wherein each of the access permission are controlled by the patient (Hacker, Abstract and col. 8 lines 4-17).

14. As to **Claim 6**, Hacker teaches the method of claim 4 further comprising: providing patient-determined restrictions on access privileges to specific parts of the patient-centric electronic medical record (Hacker, col. 8 lines 4-17).

15. As to **Claim 7**, Hacker teaches the method of claim 6 in which the restriction of access privileges are determined in part by time of entry or place of entry (Hacker, col. 8 lines 4-17, the Examiner takes the position that the place of entry may be a pharmacy, as in the example disclosed by Hacker).

16. As to **Claim 8**, Hacker teaches the method of claim 1 further comprising: querying a legacy datastore to select legacy records related to the patient to obtain at least some of the data items about the patient (Hacker, col. 8 lines 18-45); upon determining that a selected legacy record is in a non-open source format, translating the selected record to an open source format before storing the selected record as a data item in the patient-centric electronic medical record (Hacker, col. 8 lines 18-45).

17. As to **Claim 9**, Hacker teaches the method of claim 5 further comprising: using a specific client-optimized dictionary to translate legacy records into standardized terminology (Hacker, col. 8 lines 18-21); and storing the translated legacy record as a data item in the patient-centric electronic medical record (Hacker, col. 8 lines 4-17).

18. As to **Claim 10**, Hacker teaches an open source medical record system using the method of claim 1 (Hacker, col. 7 lines 54-56).

19. As to **Claim 12**, Hacker teaches the method of claim 1 further comprising maintaining the patient-centric electronic medical record as a secure internet-based record data set (Hacker, col. 10 lines 47-59).

20. As to **Claim 13**, Hacker teaches the method of claim 1 further comprising: storing the patient-centric electronic medical record in an encrypted, secure server (Hacker, col. 8 lines 46-59, col. 4 lines 3-20).

21. As to **Claim 14**, Hacker teaches the method of claim 13 further comprising: decrypting the patient-centric electronic medical record only in response to a private key provided by the patient (Hacker, col. 8 lines 46-59, col. 4 lines 3-20).

22. As to **Claim 15**, Hacker teaches the method of claim 14 further comprising: providing encryption/decryption software to encrypt and decrypt the patient-centric electronic medical record to a local computer on a temporary basis by the secure server (Hacker, col. 8 lines 46-49, the Java Applet Hacker discloses can be used as an encryption/decryption tool); and deleting the encryption/decryption software from the local computer when it is no longer needed to encrypt or decrypt the patient-centric electronic medical record (Hacker, col. 4 lines 6-10, the Examiner takes the position that the act of logging off the user as reference by Huerga results in the deletion of the encryption/decryption tool, see also Huerga, at least paragraph 19).

23. As to **Claim 16**, Hacker teaches the method of claim 1 in which costs and expenses associated with the providing and/or maintaining the patient-centric electronic

medical record are hospital financed and provided to patients via their physicians and/or through a hospital (Hacker, col. 9 lines 60-67).

24. As to **Claim 17**, Hacker teaches the method of claim 1 further comprising: cross-referencing summary medication lists stored as data items in the patient-centric electronic medical record to drug interaction tables and age appropriate dosage tables to reduce of medical errors (Hacker, col. 9 lines 39-45).

25. As to **Claim 18**, Hacker teaches the method of claim 1 in which the patient-centric electronic medical record comprises summary allergy lists (Hacker, col. 8 lines 26-34).

26. As to **Claim 19**, Hacker teaches the method of claim 1 further comprising: entering data items into the patient-centric electronic medical record using wireless hand held computers (Hacker, col. 8 lines 46-65, col. 10 lines 4-18).

27. As to **Claim 20**, Hacker teaches the method of claim 1 further comprising: entering data items into the patient-centric electronic medical record using "thin client" technology so that the patient-centric electronic medical record is persistently stored only on secure, encrypted servers (Hacker, col. 7 lines 51-64, the Examiner takes the position that since Hacker utilizes web browser software on the client side, the user of the system is using "thin client" technology).

28. As to **Claim 21**, Hacker teaches the method of claim 15 wherein plain-text data items from the electronic medical record exist in a local computer only in volatile memory and non-volatile storage of the data items is allowed only on the server and



only in encrypted form (Hacker, col. 8 lines 46-49, the Examiner takes the position that since the user accesses their medical data via a standard web browser in combination with a decryption/encryption tool, the textual records are kept in volatile memory. The data items kept in non-volatile storage are in encrypted form, since the private key and decryption tool are required to be used together to decode the data).

29. As to **Claim 22**, Hacker teaches the method of claim 1 further comprising using templated data entry forms (Hacker, col. 8 lines 41-55, the Examiner takes the position that data entry forms are inherently template-based).

30. As to **Claim 23**, Hacker teaches the method of claim 22 wherein the templated data entry forms comprise medical/surgical specialty and sub-specialty specific templates (Hacker, col. 8 lines 41-55, the term surgical is a subset of medical as disclosed by Hacker, col. 7 lines 27-33).

31. As to **Claim 24**, Hacker teaches the method of claim 1 further comprising using free form record entries. F. method of claim 1 further comprising using indexed keywords in free form record entries (Hacker, col. 9 lines 1-7).

32. As to **Claim 25**, Hacker teaches the method of claim 1 further comprising using indexed keywords in free form record entries (Hacker, Figure 3).

33. As to **Claim 26**, Hacker teaches the method of claim 3 further comprising: maintaining an audit trail within the medical record in which every change to a patient-centric electronic medical record is logged by date and time of entry retaining the

original record, the record change and a value indicating the identity of the author or initiator of the change (Hacker, col. 6 lines 61-63, col. 10 line 60 to col. 11 line 4).

***Claim Rejections - 35 USC § 103***

34. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker (US 6,988,075), in view of Sabol et al. (US 2004/0122719 A1).

36. As to **Claim 11**, Hacker does not specifically disclose the method of claim 1 in which the patient-centric electronic medical record uses a standardized vocabulary-based on the standard XML-HL7. However, it is well known in the art as evidenced by Sabol, that, standardized protocols based on XML have been used to maintain patient-owned medical records (Sabol, paragraphs 0048 and 0310).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to employ multiple forms in managing patient medical records as disclosed by Sabol with the system of centrally storing patient-controlled medical records as taught by Hacker, since the system of Sabol is also directed towards the interaction of patient-controlled access (Sabol, see for example paragraph 0364).

***Conclusion***

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Snowden et al. "System and method for automated creation of patient controlled records" (US 2002/0026332 A1).

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SIND PHONGSVIRAJATI whose telephone number is (571) 270-5398. The examiner can normally be reached Monday - Thursday 8:00am-5:00pm (ET).

39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Application: 10/773,738

Paper No. 20080515

Art Unit: 4176

Page 11

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/S. P./  
Examiner, Art Unit 4176  
15 May 2008

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 4176